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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/033,328

11/02/2001

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T015-P07180US

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33356 7590 12/17/2010
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EXAMINER

STRANGE, AARON N

ART UNIT

PAPER NUMBER

2448

NOTIFICATION DATE

DELIVERY MODE

12/17/2010

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DARRIN M. PATEK, SHAUN CLEM, TODD L. KHACHERIAN,
JIMMY PU, and CHRIS REED

Appeal 2009-006218
Application 10/033,328
Technology Center 2400

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

I. STATEMENT OF THE CASE

Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter “Request”) on November 23, 2010, for reconsideration of the Decision mailed September 23, 2010 (hereinafter “Decision”) with respect to claims 22-24 (Request 1).

The Decision affirmed the Examiner’s rejections of claims 1-7, 14, 16, 18, 21, and 25 under 35 U.S.C. § 102(b) and of claims 8-13, 15, 17, 19, 20, and 22-24 under 35 U.S.C. § 103(a). The Request only addresses the affirmance of the rejection of claims 22-24 under 35 U.S.C. § 103(a) over Chin in view of Nolan, and thus, the affirmance of the other rejections is not the subject of this Request (Request 1-6).

We have reconsidered the panel’s Decision of September 23, 2010 regarding claims 22-24 under 35 U.S.C. § 103(a) over Chin in view of Nolan, in light of Appellants’ comments in the Request, and we find Appellants have not identified any points misapprehended or overlooked by the Board in the Decision to affirm the rejection of claims 22-24 under 35 U.S.C. § 103(a). We decline to change the Decision for the reasons discussed *infra*.

II. ISSUE

The issue we address on this Request is whether Appellants have identified any points misapprehended or overlooked by the Board in holding claims 22-24 unpatentable.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appeal Brief

1. As to claims 22-24, in the Appeal Brief, Appellants merely contended that “China and Nolan nowhere teach or suggest the ‘first crossbar switch’, the ‘second crossbar switch’, nor a ‘control unit for selecting said plurality of selected output ports using a multicast data structure having predetermined multicast routes’” (App. Br. 11).

Examiner’s Answer

2. In the Examiner’s Answer, the Examiner found that Chin “discloses a first crossbar switch for transferring a frame from an input port to shared memory (receive circuitry of the switch ports)..., a second crossbar switch for transferring said frame to a plurality of selected output ports (processing and forwarding circuitry)..., and a control unit for selecting said plurality of selected output ports using a multicast data structure having predetermined multicast routes (the portion of the switching fabric circuit that maintains and uses the forwarding table to make routing decisions)” (Ans. 7). In particular, the Examiner concluded that “the claimed ‘first crossbar switch’ corresponds to Chin’s receive circuitry of the switch ports,” “the ‘second crossbar switch’ corresponds to the ‘processing and forwarding’ circuitry,” and “the claimed control unit corresponds to

portion of the switch fabric circuit that maintains and uses the forwarding table to make routing decisions” (Ans. 13).

Reply Brief

3. In the Reply Brief, the Appellants merely repeated the language of claim 22 (Reply Br. 3-4), reproduced the language of claims 8 and 22 in a side-by-side chart for comparison (Reply Br. 4), and added the argument that “a crossbar switch is a well-known switching element having multiple inputs and multiple outputs and an array of switches for routing signals or data from each of the inputs to each of the outputs” (Reply. Br. 5). Appellants also added that “Chin’s description does not provide an enabling disclosure of any particular embodiment of the switching fabric” (*id.*).

IV. ANALYSIS

In the Request, Appellants contend that “the Board apparently interpreted [Appellants’] arguments in the Reply Brief as only that the reference fail[s] to teach or suggest the ‘first cross bar switch’, ‘the second crossbar switch’ and ‘the control unit’” (Request 2, emphasis added). Appellants then add a newly presented argument that the Appellants were “attempting to argue that the Examiner had failed to make a prima face[sic] case of obviousness and, in particular, had failed to identify where the elements of the claim (which encompass much more than simply two crossbar switches and a control unit) could be in the prior art” (*id.*).

As set forth in 37 CFR § 41.37(c)(1)(vii)(2004), any argument “not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board.” Accordingly, we refuse to consider Appellants’ newly presented argument that “the elements of the claim ... encompass much more than simply two crossbar switches and a control unit” (Request 2).

In appealing the Final Rejection in the Appeal Brief, Appellants merely contended that “Chin and Nolan nowhere teach or suggest the ‘first crossbar switch’, the ‘second crossbar switch’, nor a ‘control unit for selecting said plurality of selected output ports using a multicast data structure having predetermined multicast routes’” (FF 1). Appellants, however, provided no explanation as to how or why the “first crossbar switch,” the “second crossbar switch” and the “control unit” are different from the circuitry of Chin in view of Nolan. Instead, Appellants merely summarized Chin and Nolan and simply quoted the claim language (*id.*), which we found to be a mere general allegation of patentability that did not specify, as required, how the quoted language patentably distinguishes the claimed invention. This form of argument in the Appeal Brief is wholly ineffective in demonstrating error in the Examiner’s *prima facie* case to establish the patentability of the claims on appeal. *Ex parte Belinne*, Appeal No. 2009-004693, decided Aug. 10, 2009, (BPAI) (informative). Available at: www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf.

As set forth in the Examiner’s Answer, the Examiner found that “the claimed ‘first crossbar switch’ corresponds to Chin’s receive circuitry of the

switch ports,” “the ‘second crossbar switch’ corresponds to the ‘processing and forwarding’ circuitry,” and “the claimed control unit corresponds to portion of the switch fabric circuit that maintains and uses the forwarding table to make routing decisions” (FF 2).

Appellants added additional arguments in the Reply Brief in an attempt to cure the noted deficiencies in the Appeal Brief (FF 3). However, these arguments were new arguments raised for the first time in the Reply Brief. Because Appellants’ arguments could have been raised in the Appeal Brief but Appellants failed to do so, we deemed the arguments technically waived.

In our Decision, we gave the claims their broadest reasonable interpretation and interpreted a “crossbar switch” to be a switching element (Decision 9). Accordingly, we found that “[o]ne of ordinary skill in the art would have understood Chin in view of Nolan to suggest a switching fabric circuit that includes an element for transferring data packet from an input port, an element for transferring the frame to selected output ports, and a control unit for selected the output ports” (*id.*)

Though Appellants contend that the Board misinterpreted Appellants’ arguments in the Reply Brief (*id.*), as set forth in our Decision, we addressed Appellants’ arguments as set forth in the Appeal Brief, and not the Reply Brief (Decision 8). That is, since it is inappropriate for Appellants to discuss for the first time in the Reply Brief matters that could have been raised in the Appeal Brief, we addressed arguments that Appellants set forth in the Appeal Brief. As the Board has recently found, “[t]he failure to raise all

issues and arguments diligently, in a timely fashion, has consequences,” and thus, such newly-raised arguments are technically waived. *Ex parte Borden*, 93 USPQ2d 1473, 1475 (BPAI 2010) (informative decision) (“[The reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”). *Cf. Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986) and *McBride v. Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1211 (D.C. Cir. 1986).

Although such newly-raised arguments presented in the Reply Brief are technically waived, we also note that the arguments are unpersuasive. That is, though Appellants contend that “a crossbar switch is a well-known switching element having multiple inputs and multiple outputs and an array of switches for routing signals or data from each of the inputs to each of the outputs” and that “Chin’s description does not provide an enabling disclosure of any particular embodiment of the switching fabric” (Reply. Br. 5), such arguments are not commensurate in scope with the language of claim 22. That is, claim 22 does not recite any such “multiple inputs and multiple outputs and an array of switches” or any such “enabling disclosure.” Accordingly, even if we do not technically waive the arguments presented in the Reply Brief, such arguments do not persuade us to reverse the Examiner’s rejection of claims 22-24 over Chin in view of Nolan.

Accordingly, Appellants’ Request does not persuade us of any points we misapprehended or overlooked in the Decision. Moreover, Appellants’

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Request does not persuade us to reverse the Examiner's rejection of claims 22-24 over Chin in view of Nolan.

V. CONCLUSION

We have carefully considered the arguments raised by Appellants in the Request for Rehearing but find no points misapprehended or overlooked by the Board in the original Decision, and none of these arguments are persuasive that the original Decision was in error. We are still of the view that the invention set forth in claims 22-24 are unpatentable over the applied prior art based on the record before us in the original appeal. This Decision on Appellants' Request for Rehearing is deemed to incorporate the earlier Decision (mailed September 23, 2010) by reference. *See* 37 C.F.R. § 41.52(a)(1).

VI. DECISION

We have granted Appellants' request to the extent that we have reconsidered the Decision of September 23, 2010, but we deny the request with respect to making any changes therein.

REHEARING DENIED

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